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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/599,174	06/22/2000	Trevor Hamilton	ACC0786P1US	7590

7590 08/13/2003

Joan M McGillicuddy
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EXAMINER

JOLLEY, KIRSTEN

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 08/13/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/599,174

Applicant(s)

HAMILTON ET AL.

Examiner

Kirsten Crockford Jolley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29,32 and 35-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29,32 and 35-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Priority

1. Applicant is reminded that a certified copy of the foreign priority document must be provided by the applicant if the parent international application has not entered the national stage under 35 U.S.C. 371. See MPEP 1895.01.

Response to Arguments/Amendments

2. The 35 USC 112, 2nd paragraph rejections set forth in the prior Office action are withdrawn in response to Applicant's statement on the record that claims 36-38 do not require each of the elements and the claims merely state possible choices for each of the elements.
3. The Examiner acknowledges that the final Office action referred to as May 26, 2002 was indeed a typographical error and was mailed on March 26, 2002, and apologizes for any confusion.
4. Applicant's arguments filed May 27, 2003 regarding the 35 USC 103(a) rejections have been fully considered but they are not persuasive. Claims 1-29, 32, and 35-40 remain rejected over WO 93/13179 as set forth below.

Applicant argues that the claimed method requires a step of forming a coating on a substrate and that the coating comprises film-forming polymer (A) carrying unreacted curable silicon-containing functional groups providing latent reactivity. Applicant argues that WO '179 does not teach or suggest forming a coating, as opposed to a wet coating

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formulation/composition of A and then, thereafter applying a layer of B and bonding layer B to coating A by a condensation curing reaction, as in the present claims. Accordingly, Applicant states that WO '179 cannot make the claimed invention obvious, even if the present claims are broad enough to read on a wet-on-wet process, "such as two overlapping/overlying brush, roller, or spray painting strokes."

It is the Examiner's position that applying a wet layer of a coating composition meets the limitation of "forming a coating." The term "coating" is a broad term and is interpreted as being broad enough to read on both a wet composition/coating layer or a dried and cured coating layer. It is noted that "coat" is defined in Merriam-Webster's Collegiate Dictionary, Tenth Edition, as "a layer of one substance covering another." Furthermore, the phrase "forming a coating" is an active method step which is inclusive of the step of actually applying the coating composition onto the substrate, as well as the step of drying the coating. The claims do not require that the coating layer is dried and/or cured prior to applying the second coating layer on top of it (the coating comprising component (B)). Further, it is noted that, regardless of whether the coating layers are dried between their application, it none-the-less remains the Examiner's position that it would have been obvious to have applied two thinner layers of a coating composition, in place of one thicker layer, with the expectation of similar and equivalent results.

5. A telephone call was made to Lainie Parker on July 29, 2003 to state that claim 1 would appear to be allowable if Applicant changed the word "comprising" in lines 3 and 5 to -- consisting essentially of--, or alternatively if other changes were made to claim 1 to distinguish

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that polymer (A) is in the first coating layer and not material (B), and material (B) is in the second coating layer and not polymer (A). An agreement was unable to be reached at the time.

Claim Rejections - 35 USC § 103

6. Claims 1-29, 32, and 35-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 93/13179.

WO 93/13179 is applied for the same reasons discussed in the prior Office actions, as well as for the reasons discussed above in paragraph 4.

The instant claims are broad enough to read on applying two layers of WO '179's coating composition, one applied on top of the other, such as two overlapping/overlying brush, roller, or spray painting strokes. WO '179 teaches that its composition may be applied by brush-painting, roller-painting, or spray-painting on page 21. In this case, the first layer inherently comprises component (A) and the second layer inherently comprises component (B). The transitional term "comprising," which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 948) ("comprising" leaves "the claim open for the inclusion of unspecified ingredients even in major amounts"). Condensation curing would inherently occur between components (A) and (B) in the two thin coating layers. It is the Examiner's position that it would have been obvious to have applied two thin layers of WO '179's coating by brush, roller,

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or spray painting in place of one thicker layer with the expectation of similar and successful results.

Additionally, it is the Examiner's position that the functional groups on polymer (A) of WO '179 provide latent reactivity. For example, WO '179 teaches on page 17 (at the end of the third full paragraph) that a coating of the present invention will typically cure tack-free within 1 day and be fully cured within 3-4 days. While the latent reactivity of the functional groups may only exist for a limited time until reaction and full curing occurs, it none-the-less exists and therefore meets Applicant's claim limitation. Further, it is noted that the claims require that the *functional groups* of component A have latent reactivity. This is necessarily the case in the method of WO '179 as the functional groups on component A exist only until reaction with component B (at which point they are reacted and become part of the condensation product), therefore they will necessarily have latent reactivity during their existence as unreacted functional groups.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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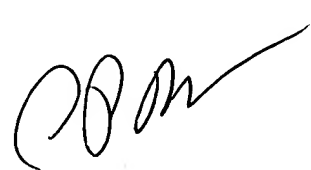
CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten Crockford Jolley whose telephone number is 703-306-5461. The examiner can normally be reached on Monday to Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on 703-308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1193.

kcj
August 8, 2003



SHRIVE P. BECK
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